



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,003	04/12/2001	Lois R. Scheirer	FOREX-001XX	1861
207	7590	07/05/2006	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP			ALPERT, JAMES M	
TEN POST OFFICE SQUARE				
BOSTON, MA 02109			ART UNIT	PAPER NUMBER
			3693	
DATE MAILED: 07/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/834,003

Applicant(s)

SCHEIRER, LOIS R.

Examiner

James Alpert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.  
2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-104 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-104 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The application, received on 04/12/2001 has been reviewed, and the Examiner has observed the necessity of restriction to achieve a satisfactory examination of the application. The claims are of such distinctiveness and complexity that prosecution without a restriction election would require time-consuming search and analysis, imposing a serious burden on the Office.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 90,1-11, drawn to a system and method for providing foreign exchange risk-related services, classified in class 705, subclass 35.
2. Claims 91,102,12-20,80, drawn to systems and methods for focusing currency exchange market data onto a user's currency exchange exposure and presenting position reports related thereto, classified in class 705, subclass 36R.
3. Claims 92,103,21-28,81-87, drawn to a systems and methods for ensuring and supporting banking standard compliance classified in 705, subclass 35.
4. Claims 93,29-33, drawn to a system and method of determining a foreign currency risk management policy, classified in class 705, subclass 35.
5. Claims 94,95,34-42,43-50, drawn to systems and methods for estimating a price reflecting a foreign currency exchange rate fluctuation, and comparing two foreign currencies relative to a target currency, classified in class 705, subclass 36R.
6. Claims 96,97,51-57,58-64, drawn to systems and methods for determining foreign currency price and fluctuation, classified in class 705, subclass 35.
7. Claims 98-99,101,65-66,79 drawn to systems and methods for populating a transaction request and displaying an exposure to foreign currency exchange rate fluctuation, classified in class 705, subclass 39.

Art Unit: 3624

8. Claims 100,67, drawn to a system and method for analyzing at least one hedge strategy, classified in class 705, subclass 37.
9. Claims 89, drawn to a system for providing foreign currency exchange risk advisory services via a server system, classified in class 705, subclass 35.

Inventions 1-8 are related as subcombinations disclosed as usable together in a single combination, thus distinct, each from the other. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, each of subcombinations 1-8 has separate utility from the remaining seven (7). See MPEP § 806.05(d). Specifically,

Invention 1 has separate utility not found in the remaining Inventions, comprising:  
determining an appropriate hedge alternative consistent with said currency exchange risk exposure.

Invention 2 has separate utility not found in the remaining Inventions, comprising:  
providing at least one display object, responsive to said user's currency exchange exposure and said currency exchange market data, wherein said at least one display object displays at least one currency exchange rate for at least one currency indicated by said user's currency exchange exposure.

Invention 3 has separate utility not found in the remaining Inventions, comprising:  
providing, responsive to said monitoring of said user actions, at least one on-line workshop in the event that said user actions include at least one predetermined user action, wherein said at least one on-line workshop presents data regarding foreign currency risk management related to said at least one predetermined user action

Invention 4 has separate utility not found in the remaining Inventions, comprising:  
providing at least one policy development question;  
obtaining, in response to said at least one policy development question, at least one user-provided answer;  
storing said at least one user-provided answer into a foreign currency risk management policy template;

Art Unit: 3624

Invention 5 has separate utility not found in the remaining Inventions, comprising:

obtaining at least one analysis period;  
obtaining exchange rates between said base currency and said foreign currency relative to said at least one analysis period; and  
calculating said corresponding price responsive to said original price, said analysis period, and said exchange rates.

Invention 6 has separate utility not found in the remaining Inventions, comprising:

obtaining at least one user problem specific variable;

Invention 7 has separate utility not found in the remaining Inventions, comprising:

displaying a current open position with regard to exposure to foreign currency exchange rate fluctuation;

Invention 8 has separate utility not found in the remaining Inventions, comprising:

displaying, responsive to said selected one of said decision categories, a predetermined analysis model corresponding to said selected one of said decision categories;

Because these inventions are distinct for being separately usable, as shown above, examining the inventions together would require searching for a reference to teaching the unique element(s) of each invention that are not found in the remaining Inventions. This would be quite burdensome, requiring multiple searches, and thus the restriction for examination purposes, as indicated, is proper.

As to Invention 9, this Invention and Inventions 1-8 are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the breadth of the language of Claim 89 is without the specificity of the eight other sets of system claims, such that different types of foreign currency advisory services other than those

Art Unit: 3624

found in Inventions 1-8 could be implemented. As well, each of the subcombinations has at least some independent elements creating separate utility that are not found in the broader claim. Because of this "two way" distinctness, searching for references would be burdensome, and restriction for examination purposes, as indicated, is proper.

### ***Reminders***

No telephone communication was placed regarding this election due to the complex nature of this application and election. See MPEP §812.01.

Applicant is reminded that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that a shortened statutory period for response to this action is set to expire 30 (thirty) days from the mail date of this letter. Failure to respond within the period for response will result in abandonment of the application. See 35 U.S.C 133, MPEP §'s 710.02, 710.02(b).

Applicant is reminded that restriction is considered proper at any time prior to a final action in the case, at the discretion of the examiner. See MPEP §811. The current restriction requirement is based upon an initial reading of the claims and specification. It is possible that further restriction maybe necessary as prosecution warrants, and a as better understanding of the application is obtained.

### ***Conclusion***

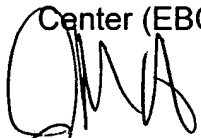
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-

Art Unit: 3624

6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).



James M. Alpert  
27 June 2005



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600